

#14
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THE UNITED STATES PATENT AND TRADEMARK OFFICE



Applicant : Stephen B. Maguire
Serial Number : 10/084,030
Group Art Unit : 3651
Filed : February 27, 2002
Examiner : Joseph A. Dillon, Jr.
Title : VACUUM LOADING SYSTEM

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RESPONSE TO SECOND RESTRICTION REQUIREMENT

MAIL STOP NON-FEE AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

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Traverse, Request For Reconsideration And Provisional Election

This is submitted in response to an office action having no paper designation number but dated 24 February 2003 wherein the examiner withdrew the restriction requirement of 30 October 2002 and levied a new restriction

requirement respecting the claims and subject matter disclosed in the above-referenced patent application.

Applicant, through his undersigned attorney, hereby traverses the second restriction requirement in all of its respects, requests reconsideration and withdrawal of the second requirement for restriction and further requests a prompt and thorough examination of all of the claims pending in the application, on their merits.

Without prejudice to the foregoing traverse and request for reconsideration and without prejudice to applicant's right to petition against the second restriction requirement, in compliance with the requirement set forth in the official action applicant provisionally elects the claims of Group I, namely claims 1 through 9 and 20 through 27, which the examiner has characterized as being directed to a receptacle for granular material, for immediate examination.

Legal, Practical and Equitable Considerations Mandate Examination of Applicant's Claims in a Single Action

A close examination of the legal, practical and equitable considerations surrounding this application compels withdrawal of the examiner's restriction requirement and requires examination of all the claims pending in the application.

In levying the restriction requirement, the examiner divided the claims pending in the application into three groups. The examiner asserted that Group I embraced claims 1 through 9 and 20 through 27 which are purportedly drawn to "a receptacle for granular material" and which the examiner asserted to be classified in class 406, subclass 123.

The examiner asserted Group II to embrace claims 10 through 19, which are purportedly drawn to a "method of loading a conveyor" and which the examiner asserted to be classified in class 406, subclass 197.

The examiner asserted Group III to consist of only claim 28 which is purportedly drawn to a "blender with pneumatic conveying", which the examiner asserted to be classified in class 406, subclass 198.

The examiner then asserted that the claims in these three groups defined inventions which were purportedly "distinct" and that such distinctness mandated restriction.

For the second time applicant respectfully notes that in the restriction context the test for whether inventions, defined by groups of claims, are "distinct" is a multi-prong test: "Distinct means that two or more subjects as disclosed are related...but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER". *MPEP 802.01*. (emphasis in the original)

The examiner asserted that the inventions of groups 1 through 3 were all related, either as a combination and subcombination (in the case of Group 1 and Group 3) allegedly being disclosed as being usable together in a single combination, or as a process (in the case of Group 2) and apparatus (in the case of Groups 1 and 3) for its practice. Hence the examiner has conceded on the record that the inventions of the three groups are "related."

The examiner then contended that the combination/subcombination groups "are distinct from each other if it can be shown that (1) the combination as

claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. The examiner then asserted that the process and apparatus groupings were distinct because either "(1) the process as claimed can be practiced by another materially different apparatus or by hand or (2) the apparatus as claimed can be used to practice another and materially different process".

Notably, as with the prior restriction requirement the examiner made *no reference whatsoever* to the patentability prong of the distinctness test, namely whether the inventions (defined by each one of the separate, allegedly distinct, groups of claims) are novel and unobviously patentable respecting the inventions defined by the other two groups of claims.

In both instances where the examiner contended that the inventions of two groups were related as "process and apparatus for its practice" (Group 1 vis-à-vis Group 2, and Group 2 vis-à-vis Group 3), the examiner contended that the process as claimed could be practiced by another materially different apparatus or "**by hand**" (emphasis added) and cited MPEP 806.05(e) as supporting authority.

In the instance where the examiner contended that the inventions of two groups were related as a combination and a subcombination, namely Group 3 vis-à-vis Group 1, the examiner asserted that the combination (Group 3) as claimed does not require the particulars of the subcombination (Group 1) as claimed "because requires a hopper" (sic). The examiner further asserted that

the subcombination (Group 1) "has separate utility such as a multistage feeder to a conveyor." The examiner cited MPEP 806.05(c) as supporting authority.

Concerning the aspect of the restriction requirement involving the method/apparatus distinction, namely the requirement for restriction of Group 2 vis-à-vis Group 1, and of Group 2 vis-à-vis Group 3, applicant respectfully submits that the restriction requirement is unsupportable and should be withdrawn.

The examiner asserted in both instances in support of the method/apparatus restriction requirement that "the process as claimed can be practiced by hand". This is incorrect. Claim 10, the independent method claim in Group 2, recites as the first step of the claimed method "drawing a vacuum within a receptacle thereby inducing plastic resin material flow".

Applicant respectfully notes that it is impossible to draw a vacuum "by hand" and that it is also clearly impossible to draw manually, i.e. with one's hand, a vacuum within a receptacle which would be sufficient to induce plastic resin material flow into that receptacle. This being the case, the examiner's contention, and one of the stated bases for the alleged distinction between and among the claims of Group 1 vis-à-vis Group 3 and Group 2 vis-à-vis Group 3, is incorrect and untenable.

As a second and final basis for requiring restriction between the inventions of Groups 2 and 1 the examiner has asserted that the process as claimed in the claims of Group 2 could be practiced by "an apparatus which does not include a means for documenting stoppage." Applicant respectfully submits that the claims

of Group 1 do not recite apparatus including "means for documenting stoppage" as contended by the examiner. Applicant respectfully submits that the examiner has apparently misread independent claims 1 and 3, which are the only two independent claims of Group 1. It may be that the examiner has construed the term "marking" in independent claim 10 of Group 2 as acquiring some type of documentation. If this is the case, this is an incorrect interpretation of claim 10. Use of the term "marking" in claim 10 means identifying the time at which drawing the vacuum is stopped responsively to material level within a receptacle.

For the foregoing reasons, applicant respectfully submits that both of the examining attorney's bases for restriction among of the claims of Groups 2 and 1 is misplaced and, accordingly, the restriction requirement as between the claims of Group 2 and Group 1 should be withdrawn.

The examiner's second basis for restriction between the claims of Group 2 and Group 3 is that the process as claimed could purportedly be practiced by another, materially different, apparatus, such as "an apparatus which does not blend materials".

Applicant concedes that the process defined by claim 10, which is the only independent claim of Group 2, could be practiced by apparatus which did not involve blending of materials. Indeed, the process defined by claim 10 could be used, and may well be used, to fill a hopper with resin material where the hopper leads directly to a injection molding machine or an extruder. Blending is not a part of the process of interest with respect to claim 10. Even though this is the case, the entire thrust of the patent application is providing granular resin

material to various receptacles which may be used in different parts of a plastic product manufacturing operation, whether that operation be injection molding, compression molding, extrusion, casting or some other means. This being the case, applicant respectfully submits that the fact that the process as claimed in claim 10 could be practiced at many positions in different manufacturing operations does not militate against the examination of the claims of Group 2 together with the claim of Group 3. Applicant again respectfully submits that the restriction requirement as between the claims of Group 2 and 3 should be reconsidered and withdrawn.

As to the "combination/subcombination" restriction involving the claim of Group 3 vis-à-vis the claims of Group 1, the examiner contends that the combination (claim 28 defining Group 3) as claimed does not require the particulars of the subcombination as claimed (claims 1 through 9 and 20 through 27) "because requires a hopper (sic)". Apparently the examiner is contending that claim 28 requires a hopper. The examiner goes on to contend that "the subcombination as separate utility such as a multistage feeder to a conveyor".

Applicant submits that this is a distinction without a difference. Claim 1 as drafted does include a hopper but the hopper is only recited as something which might receive the granular material from the apparatus which is claimed. The *hopper does not form a part of the claim and is not an element of the claim*. The word "hopper" could easily be replaced by many other components found in a system or factory which processes granular plastic resin material into finished plastic parts whether by injection molding, compression molding, extrusion,

casting or some other process. Claim 1 and the claims depending therefrom define apparatus which is usable with many such components in such manufacturing systems. To require restriction as between the claims of Group 1 and the single claim of Group 3, on the basis that independent claim 1 recites a "hopper", exalts form over substance and serves no useful purpose with respect to the examination of the claims pending in this patent application. Applicant respectfully submits that the restriction requirement as between the claims of Groups 1 and 3 based on the subcombination/combination rationale is misplaced and should be reconsidered and withdrawn.

Applicant further respectfully notes that, **for purposes of restriction analysis only** and without prejudice to whatever position applicant may take on patentability in the course of prosecution of the claims on their merits, the claims in the groups into which they have been segregated by the examiner may not be patentable over one another. Without prejudice to that position, applicant respectfully notes that whether or not the claims of the respective groups are patentable over one another, **it is the examiner's burden** to show lack of patentability of the groups of claims vis-à-vis one another in order to satisfy the patentability prong of the distinctness test.

Applicant respectfully notes that the restriction requirement is silent respecting the patentability of any claim, in any one of the groups of claims, vis-à-vis any claim in any of the other groups. Applicant further respectfully notes that the fact that the claims have been arbitrarily categorized into separate classes and subclasses by the examiner in levying the restriction requirement

does not address the issue of the patentability of the groups of claims vis-à-vis one another, in the context of the patentability prong of the distinctness test for purposes for restriction analysis. Indeed, applicant notes that there are common elements shared by the independent claims the examiner segregated into separate, purportedly "distinct", groups.

For the foregoing reasons, applicant respectfully submits that the examiner's restriction requirement is erroneous, does not meet the controlling criteria for a finding of distinctness and should be withdrawn.

The examiner has further based the distinctness position on an assertion that the inventions defined by the separate groups of claims are distinct because they purportedly "have acquired a separate status in the art as shown by their different classification...". Applicant respectfully submits that this tenuous conclusion does not support a finding of distinctness. Classification in the sense used by the examiner relates to where the patents, which might issue containing such claims, would be classified. Asserting that the presumably issuing patents would be differently classified presumes that the claims of the prospective patents would be patentably distinct one from another. However, as demonstrated above, there has been no showing by the examiner of patentable unobviousness among the groups of claims. Without a showing of patentable unobviousness among the groups of claims, the assertion that the claims in the groups, were they to issue in different patents, would be in different classes is unsupported speculation.

The Required Scope Of The Search

The most salient consideration for insisting upon restriction and determining the propriety of a restriction requirement is the scope of the examiner's search for prior art. Applicant is entitled to a full and thorough search of the prior art as a consequence of having filed his application and having paid the statutory application fee:

The director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the director shall issue a patent therefor. 35 U.S.C. 131

Restriction is proper only where an examiner would be unduly burdened by searching numerous, **unrelated** inventions or technologies. The scope of a search for arguably related inventions, even though possibly burdensome, cannot by itself justify restriction of related inventions. If an application includes claims to **related** inventions that happen to be distinct or independent inventions, the examiner **must** examine the application on its merits, in its entirety, if the search and examination of the entire patent application can be made without a serious burden on the examiner:

If the search and examination of **an entire application** can be made without serious burden, the examiner **must examine it on the merits, even though it includes claims to independent or distinct inventions**. MPEP 803.

In developing a search strategy and mapping the scope of a search, claims are to be given their broadest reasonable interpretation, both literally and by equivalents:

All subject matter that is the equivalent of the subject matter as defined in the claim, even though specifically different from the definition in the claim, must be considered unless

expressly excluded by the claimed subject matter. MPEP
904.01(b)

The examiner will not be unduly burdened by searching and examining all of the claims presented by applicant in this application. The examiner's search will not be narrowed or reduced by compliance with the restriction requirement, since applicant has clearly manifested his intent to claim each novel and nonobvious aspect of the disclosed subject matter as evidenced by the claims in the application.

The examiner's instructional guidelines for performing a search for any application are set forth in the MPEP. The guidelines require the examiner to search in classes and subclasses in which arguably distinct (as defined by the MPEP) inventions would be classified:

"Not only must the art be searched with which the invention claimed is classifiable, but **also all analogous arts regardless of where classified.**

The determination of when arts are analogous is at times difficult. It depends upon the necessary essential function or utility of the subject matter covered by the claims, and not upon what it is called. MPEP 904.01(c) (emphasis added).

A proper field of search normally includes the subclass in which the claimed subject matter of an application would be properly classified...

In outlining a field of search the examiner should note every class and subclass under the U.S. Patent Classification system and other organized systems of literature, **that may have material pertinent to the subject matter as claimed.** Every subclass, digest and cross reference art collection pertinent to each type of invention claimed should be listed, from the largest combination through the various subcombinations to the most elementary part. **The search should extend to all probable areas relevant to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed.** MPEP 904.02(a) (emphasis added).

It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, **commensurate with the limitations appearing in the most detailed claims** in the case, be made in preparing the first action ... It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; **but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment.** MPEP 904.03, ¶ 1 (emphasis added)

In doing a complete search, the examiner should find and cite **references that, while not needed for treating the claims, would be useful for forestalling the presentation of claims to other subject matter** regarded by applicant as his or her invention, by showing that this other subject matter is old or obvious. MPEP 904.03 ¶ 2 (emphasis added)

In selecting the references to be cited, the examiner should carefully compare the references with one another and with the applicant's disclosure... MPEP 904.03 ¶ 3.

From the above-quoted guidelines, it is clear that the scope of a proper search includes:

- (1) Classes and subclasses in which the claimed subject matter is classified;
- (2) Classes and subclasses that may have material pertinent to the claimed subject matter;
- (3) Classes and subclasses containing subject matter present in the disclosure which might reasonably be expected to be claimed during the prosecution; and
- (4) Classes and subclasses that may contain subject matter disclosing material related to features which might reasonably be expected to be claimed.

Given this mandate, applicant submits that all of the classes defined by the examiner as those in which the claims of this application arguably reside, must be searched no matter which group of claims applicant elects for immediate prosecution.

The Proposed Restriction Would Be Unduly Economically Burdensome On Applicant

While the Patent and Trademark Office has a legitimate interest in obtaining proper revenue from filing, issuance and maintenance fees, it does not have unrestrained power to tax inventors or the entrepreneurial enterprises employing them. Applicant is entitled to obtain patent protection on each of the nonobvious inventive aspects of the subject matter which applicant has disclosed. If the applicant is forced to divide this application into three separate patent applications as suggested by the examiner, this will be unduly and unfairly burdensome to the applicant due to the extra fees and costs associated with prosecuting and maintaining three additional patents.

Table 1 sets forth the divisional application filing costs which would be incurred by the applicant in the event the restriction requirement stands:

TABLE 1: DIVISIONAL APPLICATION FILING COST

Group Number	I	II	III
Independent Claims	2	2	1
Excess Independent Claims	0	0	0
 Total Claims	 17	 10	 1
Excess Claims	0	0	0

Filing Fee	<u>375.00</u>	<u>375.00</u>	<u>375.00</u>
Already Paid by Applicant at Filing		\$513.00	
Already Paid by Applicant to Add Claims 25-28		<u>\$69.00</u>	
Filing & Claims Fees Paid by Applicant to Date		\$582.00	

As can be seen from Table 1, applicant will be forced to pay additional filing fees in the amount of \$750.00 (2 x \$375.00) to file two divisional applications in the event the restriction requirement is not withdrawn.

As further indicated on Table 1, applicant has already paid \$582.00 in filing and claims fees to date. If applicant is forced to adhere to this second restriction requirement, two hundred seven dollars (\$207.00) of this will be forfeited since three independent claims and 10 claims in total will not be examined in the instant application despite the fact that applicant has already paid the fees therefor. Indeed, applicant will be forced to pay \$750.00 additional to secure examination of three independent claims and the seven dependent claims for which applicant has already paid. Hence, applicant will incur an initial, non-recoverable penalty of \$957.00 (\$750.00 + \$207.00) in the event applicant is required to adhere to the outstanding restriction requirement and file divisional applications for the two non-elected groups of claims.

Applicant further notes that the figures given in Table 2 do not include attorney fees, associated costs and expenses. The attorney fees associated with filing each such divisional patent application would probably be around

\$1,000.00; this figure is taken by analogy from the figure appearing in the AIPLA Report of Economics Survey 2001 for the filing of a previously prepared U.S. patent application in the United States as a PCT application in the United States as the receiving office from either a previously prepared U.S. patent application as the PCT application or a foreign origin PCT application. Furthermore, the applicant will be faced with preparing amendments and arguments in response to official actions to be issued by the United States Patent and Trademark Office. Again based on the AIPLA Report of Economic Survey 2001, from figures given for the costs to prepare an amendment and argument of minimal complexity it can be expected that the applicant will face fees of in the neighborhood of \$2,000.00 for each amendment and argument which may be required in response to an official action. Additionally, there will be attorney fees associated with the payment of any issue fee if allowed claims are obtained and this will amount to about \$600.00 per application, again based on the AIPLA Report of Economic Survey 2001. Add to this fees for the preparation and filing of information disclosure statements, and the ordinary and routine reporting letters to the client, the result is that the attorney fees associated with the filing and prosecution of the two divisional applications could easily amount to \$6,000.00 or \$7,000.00 per application, leading to a further incremental cost to the applicant from \$12,000.00 to \$14,000.00 if the restriction requirements stands.

Table 2 presents the patent issue fees and maintenance costs applicant will face in the event the restriction requirement stands and applicant is

successful in prosecuting the parent application and two divisional applications to allowance:

TABLE 2: PATENT MAINTENANCE COST

Number of Patents	1	2	3
Issue Fee	650.00	1300.00	1950.00
1 st Maintenance Fee	445.00	890.00	1335.00
2 nd Maintenance Fee	1025.00	2050.00	3075.00
3 rd Maintenance Fee	<u>1575.00</u>	<u>3150.00</u>	<u>4725.00</u>
TOTAL	\$3,695.00	\$7,390.00	\$11,085.00

Even from Table 2, which presents the maintenance fee costs at today's levels, it is apparent that applicant will face issue and maintenance fees amounting to \$7,390.00 extra, over and above the cost to issue and maintain a single patent directed to the invention, if the restriction requirement stands. When this figure is combined with the figures discussed above, the total financial penalty applicant potentially faces in official fees alone amounts to \$8,347.00 as a result of the restriction requirement. Applicant respectfully submits that applicant should not be burdened in this manner and that the restriction requirement should be reconsidered and withdrawn in its entirety.

**The Patent Office's Responsibility Is Public Service,
Not Revenue Generation**

While applicant recognizes the Patent and Trademark Office interest in obtaining proper revenue from filing and issuance fees, applicant again asserts

that the Patent and Trademark Office is not in the business of assisting the IRS in financing the war on terrorism or reducing the national debt. The sole function of the Patent and Trademark Office is to serve inventors and the public in an efficient and expeditious manner. The Patent and Trademark Office is charged with a duty to carry out its responsibility of examining patent applications thoroughly and efficiently. Efficient use of administrative resources and expeditious processing of this application will be better served by performing one comprehensive search, as contrasted to three largely, if not completely, overlapping searches of the classes defined by the examiner in levying the erroneously-based restriction requirement.

Conclusion

For all of the foregoing reasons, applicant respectfully submits that the restriction requirement set forth in the paper dated 24 February 2003 is not well founded and should be withdrawn. Applicant again requests prompt and thorough examination of all of the claims pending in the application.

Finally, for the convenience of both the examiner and applicant's counsel there is included herewith as an attachment a clean copy of the claims pending in the application with the status of each claim indicated in accordance with the requirements for indication of claim status.

To the extent there is any fee required in connection with the receipt, acceptance and/or consideration of this paper and/or any accompanying papers submitted herewith, please charge all such fees to deposit account 50-1943.

Respectfully submitted,

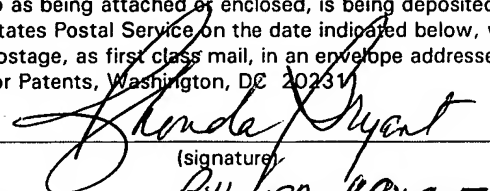
24 July 2003



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